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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/674,841

09/30/2003

Simon Chu

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06/28/2006

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EXAMINER

NEWAY, SAMUEL G

ART UNIT

PAPER NUMBER

2194

DATE MAILED: 06/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/674,841

Applicant(s)

CHU ET AL.

Examiner

Samuel G. Neway

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

1. Claims 1 – 18 are pending and are considered below.

## **DETAILED ACTION**

### ***Specification***

2. The disclosure is objected to because of the following informalities: in paragraph 27 “sua sponte” in the last sentence is believed to be a typographical error. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 8, and 15 recite the limitation "the first software" in the last three lines. There is insufficient antecedent basis for this limitation in the claims.

5. Claims 3 and 10 recite the limitation "the requested software download" in the first three lines. There is insufficient antecedent basis for this limitation in the claims. However, it is believed claims 3 and 10 should depend on claims 2 and 9 respectively and are treated as such below.

### ***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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7. Claims 15 – 18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 15 – 18 are directed to a computer program “residing on a computer usable medium”. But, according to the specification, the computer usable medium can be “communication media” which is considered non-statutory absent being claimed in combination the necessary hardware to receive and convert the signal to computer usable code.

Note that amending claims 15 – 18 to read -- residing on a computer storage medium -- would overcome this rejection in a manner consistent with Applicant's specification.

### ***Double Patenting***

8. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

9. Claims 1 – 7 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1 – 7 of copending Application No. 10/698,719. This is a

provisional double patenting rejection since the conflicting claims have not in fact been patented.

Current Application	Application No. 10/698,719
<p>1. A method for regulating a download of a software from a server to a client computer on a network, the regulating being determined by a physical location of the client computer on which the software is to be downloaded, the method comprising: storing a first list of authorized location ranges where a client computer is authorized to receive a download of a software from a server; determining a physical location of the client computer; comparing the physical location of the client computer with the first list of authorized location ranges; and downloading the first software only if the physical location of the client computer is within the range of one of the authorized location ranges from the first list of authorized location ranges.</p> <p>2. The method of claim 1, further comprising: upon determining that the physical location of the client computer is not within the first list of authorized location ranges, requesting a download of a second software, the second software having a second list of authorized location ranges; comparing the physical location of the client computer with the second list of authorized location ranges, and downloading the second software only if the physical location of the client computer is within the range of one of the authorized location ranges from the second list of</p>	<p>1. A service for regulating a download of a software from a server to a client computer on a network, the regulating being determined by a physical location of the client computer on which the software is to be downloaded, the service comprising: storing a first list of authorized location ranges where a client computer is authorized to receive a download of a software from a server; determining a physical location of the client computer; comparing the physical location of the client computer with the first list of authorized location ranges; and downloading the first software only if the physical location of the client computer is within the range of one of the authorized location ranges from the first list of authorized location ranges.</p> <p>2. The service of claim 1, further comprising: upon determining that the physical location of the client computer is not within the first list of authorized location ranges, requesting a download of a second software, the second software having a second list of authorized location ranges; comparing the physical location of the client computer with the second list of authorized location ranges, and downloading the second software only if the physical location of the client computer is within the range of one of the authorized location ranges from the second list of</p>

<p>authorized location ranges.</p> <p>3. The method of claim 1, further comprising: upon determining that the client computer is not located within an authorized area for the requested software download, generating an alert to a software administrator server of the unauthorized area in which the client computer is located while attempting to download a restricted application.</p> <p>4. The method of claim 2, wherein the first and second lists of authorized location ranges are stored in the server.</p> <p>5. The method of claim 1, wherein the physical location of the computer is determined from a Global Positioning System (GPS) signal.</p> <p>6. The method of claim 1, wherein the physical location of the computer is determined from a local enterprise generated signal.</p> <p>7. The method of claim 6, wherein the local enterprise generated signal is confined to a single room.</p>	<p>authorized location ranges.</p> <p>3. The service of claim 1, further comprising: upon determining that the client computer is not located within an authorized area for the requested software download, generating an alert to a software administrator server of the unauthorized area in which the client computer is located while attempting to download a restricted application.</p> <p>4. The service of claim 2, wherein the first and second lists of authorized location ranges are stored in the server.</p> <p>5. The service of claim 1, wherein the physical location of the computer is determined from a Global Positioning System (GPS) signal.</p> <p>6. The service of claim 5, wherein the physical location of the computer is determined from a local enterprise generated signal.</p> <p>7. The service of claim 6, wherein the local enterprise generated signal is confined to a single room.</p>
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The service claims of Application No. 10/674,841 comprise only a series of steps (i.e. process/method) therefore the claims in the different applications are patentably identical.

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct

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from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 15, 16, 17, and 18 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2, 4, and 5, respectively, of copending Application No. 10/698,719.

Current Application	Application No. 10/698,719
<p>15. A computer program product, residing on a computer usable medium, for regulating a download of a software from a server to a client computer on a network, the regulating being determined by a physical location of the client computer on which the software is to be downloaded, the computer program product comprising: program code for storing a first list of authorized location ranges where a client computer is authorized to receive a download of a software from a server; program code for determining a physical location of the client computer; program</p>	<p>1. A service for regulating a download of a software from a server to a client computer on a network, the regulating being determined by a physical location of the client computer on which the software is to be downloaded, the service comprising: storing a first list of authorized location ranges where a client computer is authorized to receive a download of a software from a server; determining a physical location of the client computer; comparing the physical location of the client computer with the first list of authorized location ranges; and</p>

<p>code for comparing the physical location of the client computer with the first list of authorized location ranges; and program code for downloading the first software only if the physical location of the client computer is within the range of one of the authorized location ranges from the first list of authorized location ranges.</p> <p>16. The computer program product of claim 15, further comprising: program code for, upon determining that the physical location of the client computer is not within the first list of authorized location ranges, requesting a download of a second software, the second software having a second list of authorized location ranges; program code for comparing the physical location of the client computer with the second list of authorized location ranges, and program code for downloading the second software only if the physical location of the client computer is within the range of one of the authorized location ranges from the second list of authorized location ranges.</p> <p>17. The computer program product of claim 16, wherein the first and second lists of authorized location ranges are stored in the server.</p> <p>18. The computer program product of claim 15, wherein the physical location of the computer is determined from a Global Positioning System (GPS) signal.</p>	<p>downloading the first software only if the physical location of the client computer is within the range of one of the authorized location ranges from the first list of authorized location ranges.</p> <p>2. The service of claim 1, further comprising: upon determining that the physical location of the client computer is not within the first list of authorized location ranges, requesting a download of a second software, the second software having a second list of authorized location ranges; comparing the physical location of the client computer with the second list of authorized location ranges, and downloading the second software only if the physical location of the client computer is within the range of one of the authorized location ranges from the second list of authorized location ranges.</p> <p>4. The service of claim 2, wherein the first and second lists of authorized location ranges are stored in the server.</p> <p>5. The service of claim 1, wherein the physical location of the computer is determined from a Global Positioning System (GPS) signal.</p>
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Although the conflicting claims are not identical, they are not patentably distinct from each other because it is obvious and well known to program processes and run them on a computer in order to improve performance.



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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 102***

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 1, 5, 8, 12, 15, and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Kyotoku (USPGPub 2003/0110011).

13. As to claims 1, 8 and 15:

Kyotoku discloses a service for regulating a download of a software from a server to a client computer on a network, the regulating being determined by a physical location of the client computer on which the software is to be downloaded (see Abstract), the service comprising:

storing a first list of authorized location ranges where a client computer is authorized to receive a download of a software from a server (paragraphs 50, 90);

determining a physical location of the client computer (paragraphs 55, 92);

comparing the physical location of the client computer with the first list of authorized location ranges (paragraphs 57, 93);

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and downloading ("remote access") the first software only if the physical location of the client computer is within the range of one of the authorized location ranges from the first list of authorized location ranges (paragraph 94, figures 4 and 7).

As to claim 5, 12, and 18:

Kyotoky discloses the service of claim 1, wherein the physical location of the computer is determined from a Global Positioning System (GPS) signal (paragraphs 55, 92).

***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 2 – 4, 9 – 11, and 16 – 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kyotoku (PGPub 2003/0110011).

As to claims 2, 9, and 16:

Kyotoky discloses the service of claim 1, but he fails to specifically disclose the service further comprising: upon determining that the physical location of the client computer is not within the first list of authorized location ranges, requesting a download of a second software. It would have been obvious to one of ordinary skill in the art at the time the invention was made to request a second or any number of other downloads if previous requests are rejected. One would have been motivated to request a second

download because that would allow servers containing a second downloadable software to authenticate a client's location in order to push the requested software.

As to claims 3, and 10:

Kyotoky discloses the service of claim 2, further comprising: upon determining that the client computer is not located within an authorized area for the requested software download, generating an alert ("message") issued to a software administrator server (paragraph 84).

As to claims 4, 11, and 17:

Kyotoky discloses the service of claim 2, wherein the lists of authorized location ranges are stored in the server (paragraph 93).

16. Claims 6 –7, and 13 – 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kyotoku in view of Wall (USPGPub 2002/0017977).

As to claims 6, and 13:

Kyotoky discloses the service of claim 1, but does not disclose the service wherein the physical location of the computer is determined from a local enterprise generated signal. Wall discloses a similar system to control the use of software by use of location where "satellites or other alternate paths" are used to determine location (paragraphs 109, 110). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Wall's other alternative path such as local enterprise generated signal to determine physical location. One would have been motivated to use the local enterprise generated signal to determine location in case it is

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difficult to use GPS for example where GPS broadcast wave cannot reach a GPS receiver.

As to claims 7, and 14:

Kyotoky and Wall disclose the service of claim 6, Kyotoky further discloses the service wherein the local enterprise generated signal is confined to a single room ("clean room", paragraph 72).

### ***Conclusion***

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Fan (US Patent 6,552,682) discloses a method of providing a GPS location of a client computer to a server via a network, and sending location relevant information (directions, coupons) to the client computer.

Becker, Jr. et al. (US Patent 6,931,131) discloses a method and system of determining the location of a computer using GPS, and allowing the computer access to certain information from a host system via a network provided the computer is within an authorized location.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samuel G. Neway whose telephone number is 571-270-1058. The examiner can normally be reached on Mon - Thur 8:00AM - 5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Myhre can be reached on 571-270-1065. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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